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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,618	06/10/2005	Declan Patrick Kelly	NL021306	8916
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EXAMINER				
DANG, HUNG Q				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/538,618

**Applicant(s)**

KELLY, DECLAN PATRICK

**Examiner**

Hung Q. Dang

**Art Unit**

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Interval Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claim 7 is objected to because of the following informalities: Claim 7 is ended without a period. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 7 and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 7 recites, "said indication information". There is insufficient antecedent basis for this limitation in the claim.

Claims 12-13 recites "use of the method according to claim 1," and "use of personal video recorder," which are claiming to processes without setting forth any steps involved in the process. Therefore, the claims generally raise an issue of indefiniteness under 35 U.S.C. 112, second paragraph. The claims held to be indefinite because they merely recites a use without any active, positive steps delimiting how this use is actually practiced. *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986) (see MPEP 2173.05(q)).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 11 recites, "a user interface." However, it appears that such would reasonably be interpreted by one of ordinary skill in the art as software, per se. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Software does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

**Claims 12-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

MPEP 2173.05(q) reads:

In *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967), the Board held the following claim to be an improper definition of a process: "The use of a high carbon austenitic iron alloy having a proportion of free carbon as a vehicle brake part subject to stress by sliding friction." In *Clinical Products Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966), the district court held the following claim was not a proper process claim under 35 U.S.C. 181: "The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfonic acid."

Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim.

Claims 12-13 are rejected under 35 U.S.C. 101 because the claims recite a use of a method and a device without setting forth any steps involved in the process. Since the claims 12-13 do not set forth any steps involved in the process, they are not proper process claims thus do not fall within a statutory category of invention because the claimed subject matter is not limited to a process, machine, manufacture, or a composition of matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen et al. (EP 0 782 139 – hereinafter Nielsen).**

Regarding claim 1, Nielsen discloses a method of recording and playing back content to and from a personal video recorder for audio-visual content (*Fig. 1*), said recorder having a storage medium for recording television programmes (*column 1, line 50 – column 2, line 15; column 4, lines 32-49*), and of presenting information concerning

the recorded content on said recorder (*column 1, line 50 – column 2, line 15; column 4, lines 50-56*), comprising the steps of: recording of programmes of at least a first type of programmes on said storage medium of the recorder, wherein said first type of programmes comprises programmes subscribed by a user of the recorder (*column 1, lines 49-53; column 4, lines 32-49*); presenting of the recorded programmes in a summarised form in a User Interface (*column 2, lines 41-52*); and playing back a programme chosen by the user, wherein the chosen programme is one of the above recorded programmes of at least said first type of programmes (*column 2, lines 41-52; column 4, lines 50-56*).

Claim 12 is rejected for the same reason as discussed in claim 1 above.

Claim 13 is rejected for the same reason as discussed in claim 1 above.

Claim 14 is rejected for the same reason as discussed in claim 1 above.

**Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Browne et al. (WO 92/22983 – hereinafter Browne).**

Regarding claim 11, Browne discloses a user interface for a personal video recording system, wherein information is presented to a user, said user interface comprising a first user interface for subscribing to programmes for recording (*p.22—p. 24, line 12; Figs. 4-5*), and a second user interface presenting the recorded programmes, wherein recorded programmes comprise at least said subscribed programmes, whereby the user is given the opportunity to choose one of said recorded programmes for viewing on a display screen (*p. 24, lines 18-24*) or to indicate disinterest in a recorded program (*p. 25, line 24 – p. 26, line 4*).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen as applied to claims 1 and 12-14 above, and further in view of Browne.**

Regarding claim 2, see the teachings of Nielsen as discussed in claim 1 above. However, Nielsen does not disclose wherein recording of television programmes further comprises: recording of a second type of programmes on said storage medium of the recorder, wherein said second type of programmes is on a user profile of said user; and/or recording of a third type of programmes on said storage medium of the recorder, wherein said third type of programmes comprises programmes recommended by a broadcaster.

Browne discloses recording of television programmes comprises: recording of a second type of programmes on said storage medium of the recorder, wherein said second type of programmes is on a user profile of said user and/or recording of a third type of programmes on said storage medium of the recorder, wherein said third type of programmes comprises programmes recommended by a broadcaster (*p. 12, line 8 –p. 13, line 26; p. 20, lines 17-27*).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the teachings of Browne into the method disclosed by Nielsen to enhance the user interface of the method by provide more options for users to select favorite programmes for recording.

Regarding claim 4, Browne also discloses the step of deleting recorded programmes when the user indicates that there is no interest in viewing a certain recorded programme (*p. 19, lines 6-30; p. 25, line 24 – p. 26, line 4*).

Regarding claim 5, Browne also discloses the recorded programmes are deleted after a certain amount of time (*p. 19, lines 6-30; p. 25, line 24 – p. 26, line 4*).

Regarding claim 6, Browne also discloses the amount of time is controlled by the size of available storage space on said storage medium (*p. 19, lines 6-30; p. 25, line 24 – p. 26, line 4*).

**Claims 3 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Browne as applied to claims 1-2, 4-6, and 11-14 above, and further in view of Ali (US 2002/0199194 – hereinafter Ali).**

Regarding claim 3, see the teachings of Nielsen and Browne as discussed in claim 2 above. However, Nielsen and Browne do not disclose the step of presenting of the recorded programmes comprises the indication, which of the recorded programmes are based on the users subscription, based on the users profile, or recommended by a broadcaster.

Ali discloses recording of a third type of programmes on said storage medium of the recorder, wherein said third type of programmes comprises programmes



recommended by a broadcaster ([0027]) and the step of presenting of the recorded programmes comprises the indication, which of the recorded programmes are based on the users subscription, based on the users profile, or recommended by a broadcaster (Fig. 2; [0031]; [0090]).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the teachings of Ali into the method disclosed by Nielsen and Browne in order to further enhance the user interface of the method.

Regarding claim 7, Ali also discloses a step of updating user profile based on indication information (Fig. 6; [0017]; [0031]).

Regarding claim 8, Ali also discloses said user profile for recording of said second type of programmes is adapted to the user, based on the type of subscribed programmes (Fig. 6; [0031]; [0054]; [0078]).

**Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Browne as applied to claims 1-2, 4-6, and 11-14 above, and further in view of Li (US 2003/0081937 – hereinafter Li).**

Regarding claim 9, see the teachings of Nielsen as discussed in claim 1 above. However, Nielsen does not disclose the step of playing back a programme is on a pay per view basis.

Li discloses a step of playing back a programme is on a pay per view basis ([0080]).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the teachings of Li into the method disclosed by Nielsen for economic reasons.

**Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen, Browne and Ali as applied to claims 1-8 and 11-14 above, and further in view of admitted prior art (hereinafter APA).**

Regarding claim 10, see the teachings of Nielsen, Browne, and Ali as discussed in claims 2 and 3 above. However, Nielsen, Browne, and Ali do not disclose a broadcaster pays per recording of said third type of programmes.

APA discloses a broadcaster pays per recording of said third type of programmes ([0005]).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the feature of a broadcaster paying per recording of said third type of programmes for advertisement services (APA, [0005]).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Q. Dang whose telephone number is (571)270-1116. The examiner can normally be reached on IFT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hung Q Dang/  
Examiner, Art Unit 2621

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621